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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,573	02/20/2002	Isao Echizen	500.41219X00	5074

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EXAMINER

PATEL, SHEFALI D

ART UNIT PAPER NUMBER

2621

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/078,573	<b>Applicant(s)</b> ECHIZEN ET AL.	
	<b>Examiner</b> Shefali D. Patel	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 11 October 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 6-8 is/are rejected.
- 7) ☒ Claim(s) 2-5 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/11/05</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. The amendment was filed on 11 October 2005.
2. 35 U.S.C. 101 rejection made to claim 7 has been withdrawn.
3. The IDS filed on 11 October 2005 has been considered.
4. Claims 9-19 are cancelled.

### *Response to Arguments*

5. Applicant's arguments filed on 11 October 2005 (Remarks, pages 6-12) have been fully considered but they are not persuasive, for at least claims 1 and 6-7.

On page 9, applicant state that "Ogino fails to teach or suggest selecting a predetermined format conversion method in accordance with format information of the contents and converting the contents in accordance with the selected format conversion method as recited in the claims."

The examiner respectfully disagrees.

Please note at col. 7 and 8 of Ogino in detail is disclosed the conversion unit and the step of doing so. At col. 8, Ogino states, "The special effects processing unit 13 performs special effects processing according instructions from the user from the key operating unit 19. The system control unit 10 receives selection instructions...and supplies selection instruction signal to...processing unit 13." And, then the converting the contents according to the selection instruction send to the processing unit 13 as disclosed at col. 8 lines 1-47.

On page 9, applicant also states: "Ogino fails to teach or suggest trying to detect the inserted information from the converted contents as recited in the claims."

The examiner respectfully disagrees.

At col. 8 lines 48-60, the watermark decoding unit is disclosed which detect the inserted information from the converted contents.

*Claim Rejections - 35 USC § 102*

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 6 and 7-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogino (US 6,802,011).

With regard to **claim 1** Ogino discloses a digital watermark information detection method for detecting information inserted as a digital watermark from contents (Figure 1), comprising: a first step of selecting a predetermined format conversion method in accordance with format information of said contents (col. 8 lines 1-28), a second step of converting said contents in accordance with said selected format conversation method (col. 8 lines 29-47; Converting the 480I format into 480P format using the predetermined formats at col. 8 lines 1-20); and a third step of trying to detect said inserted information from said converted contents (col. 8 lines 52-60).

**Claim 6** recites identical features (broader) as claim 1 except claim 6 is an apparatus claim. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 6. Note the apparatus disclosed in Figure 1.

**Claim 7** recites identical features as claim 1 except claim 7 is a computer readable medium claim. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 7. Note the apparatus disclosed in Figure 1.

With regard to **claim 8** Ogino discloses a method for embedding information as a digital watermark (at col. 7 lines 49-59) comprising: acquiring information on a predetermined format

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conversion method to be applied on said contents (by reading unit 11, col. 7 lines 60-63); acquiring a conversion rule used for conversion of the present format of said contents in accordance with said predetermined with said predetermined format conversion (col. 8 lines 21-36) ; and embedding said information such that said information embedded as digital watermark is not lost even when said contents are converted in accordance with said format conversion rule (when conversion is applied the watermark is still there giving status of "copy once," "never copy," "copy free," col. 9 lines 35-52).

*Allowable Subject Matter*

8. Claims 2-5 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The closest prior art to Ogino and Walker et al. are directed to a digital watermark information detection method and system as disclosed in an independent claim 1.

However, the closest prior art fails to disclose anything about *a plurality of said format conversion methods are selected in said first step and said second step is performed using one of selected format conversion methods, and said digital watermark information detection method- further comprising: a fourth step of trying to detect said inserted information using other format conversion method other than said conversion method used in said second step if said inserted information is not detected from said contents converted in said third step* as disclosed in claim 2. Further, the closest prior art fails to disclose *a first step including: a first substep of obtaining said format information of said contents from said contents, and a second substep of selection said predetermined format conversion method corresponding to said obtaining format information* as disclosed in claim 5. It is for these reasons in combination with all the other elements of the claim that claims 2 and 5 would be allowable if rewritten

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in independent form including all of the limitation of the base claim and any intervening claims. Claims 3-4 are allowable for the same reason as claim 2.

*Conclusion*

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Mancuso can be reached on (571) 272-7695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shefali D Patel  
Examiner  
Art Unit 2621

January 20, 2006



JOSEPH MANCUSO  
SUPERVISORY PATENT EXAMINER